

## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/612,651	07/02/2003	Roland Chorin	P33094

## CONFIRMATION NO. 5422

GLAXOSMITHKLINE  
 Corporate Intellectual Property - UW2220  
 P.O. Box 1539  
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\*OC000000011311702\*

Date Mailed: 11/20/2003

## NOTICE REGARDING NONPUBLICATION REQUEST

The nonpublication request filed on 07/02/2003 is acknowledged.

- Applicant has requested non-publication, certifying that the invention disclosed in this application has not been and will not be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing, and has also claimed the benefit of an application filed in another country or under a multilateral agreement. Because this certification is inconsistent with the priority claim, the Office has scheduled this application for publication in accordance with 37 CFR 1.211(a). If applicant considers the certification submitted with this application to be consistent with the priority claim and persists in requesting that this application not be published pursuant to 37 CFR 1.211, applicant has a non-extendable time period of thirty (30) days from the mail date of this notice to provide a satisfactory explanation as to how the certification submitted with this application is valid in light of the priority claim.

Questions regarding this notice may be directed to the Office of Initial Patent Examination at (703) 308-1202.

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH  
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ON 5 December 2003

*Karen L. Klemens*  
ATTORNEY FOR APPLICANT

*5 December 2003*  
DATE

Attorney Docket No.: P33094

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Chorin et al.  
Serial No.: 10/612,651  
Filed: 2 July 2003  
For: Novel Compositions

Examiner: unknown

Art Unit: unknown

Commissioner for Patents  
Office of Initial Patent Examination  
P.O. Box 1450  
Alexandria, VA 22313-1450

**COMMUNICATION**

Sir:

Applicants respectfully request reconsideration of the Notice Regarding Nonpublication Request mailed 20 November 2003 (copy enclosed), which denied their prior request for nonpublication.

According to the Notice, the Office denied Applicants' request because the application claimed priority from "an application filed in another country." That position, however, is contrary to a full reading of the statute governing nonpublication, 35 USC § 122(B)(i), because the priority applications were not subject to a requirement for publication 18 months after filing. Specifically, when read in full, Section 122(B)(i) provides that:

If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country ... that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

In the present case, the priority applications are two British patent applications, which were filed with the purpose of establishing a priority date. These will not be published 18 months after filing because they are treated as having been withdrawn (Patents Act 1977, section 16 (1)). They are treated as having been withdrawn because



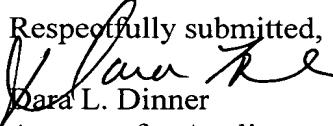
the necessary search and examination fees, due 12 months after filing date, have not been paid in time. Failure to pay such fees ultimately leads to the application being treated as withdrawn (Patents Act 1977, sections 17(1) and 18(1), respectively). Thus, this situation mirrors completely the reliance on a US provisional application that is similarly abandoned after 12 months and is not published 18 months after filing. Of course, reliance on the US provisional application for priority does not preclude a request for nonpublication under Section 122(B)(i).

Moreover, at the time the certification for nonpublication was made, Applicants had decided not to file any national applications, other than the present application in the USPTO, based on these two priority applications. The present USPTO case is the only national application based on the British priority application. There have been no publications based on the British priority applications.

Finally, the USPTO interpretation of the rules provides for a very segregationist view of the regulations. Under the present reading, the only way in which to benefit from the nonpublication request is to claim priority from a US provisional application. This reading does not permit Applicants to file a priority application in their own country as a provisional application.

Consequently, in view of these statements Applicants respectfully request that the USPTO accept the Petition for Non-Publication of the above noted application. If the Office does not accept this interpretation of the regulations, Applicants respectfully request that this Communication be treated as a Petition under 37 CFR § 1.182 for resolution of this matter.

Should there be any questions concerning this matter, please contact the undersigned at the number below. If any additional fees or charges are required by this paper the Commissioner is hereby authorized to charge Deposit account 19-2570 accordingly.

Respectfully submitted,  
  
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December 5, 2003

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